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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,661	09/19/2003	Taku Hoshizawa	16869N-094800US	8578
20350	7590	04/19/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LU, CHARLES EDWARD	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/665,661	HOSHIZAWA ET AL.
Examiner	Art Unit	
Charles E. Lu	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 19 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/17/2003</u> .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. Claims 1-14 have been submitted for examination.
2. Claims 1-14 have been rejected.

### *Drawings*

#### **3. The drawings are objected to because of the following informalities:**

**Fig. 3** should be labeled “Prior Art” because the specification appears to describe Fig. 3 with respect to the prior art (e.g., p. 7, ll. 8-9). Other figures that represent prior art should also be labeled “Prior Art”.

**As to Fig. 11,** “#1001” should be changed to #1101 to be consistent with the specification. The drawings should be carefully checked to ensure that all reference numerals are mentioned correctly in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

#### **4. The specification is objected to because of the following informalities:**

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the prior art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Appropriate corrections are required.

### ***Claim Objections***

#### **5. Claims 1 and 7 are objected to because of the following informalities:**

**As to claim 1, line 5,** "managing first file" should be written as managing a first file. Other instances of the above should also be corrected (e.g., line 7).

**Claim 7** is objected to for similar reasons as claim 1.

As to Intended use statements (e.g., **claims 12 and 14**), the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning

of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**7. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Claim 1** appears to be drawn to a recording medium recording a mere arrangement of data, which is non-statutory. See Interim Guidelines, Annex IV.

**Claims 2-6** are rejected because they depend from rejected claim 1 and do not cure claim 1's deficiencies.

**Claim 7** is rejected for similar reasons as claim 1.

**Claims 8-14** are rejected because they depend from a rejected parent claim and do not cure the efficiencies of the parent claim.

The art rejection of claims 1-14 is applied in anticipation of Applicant amending the claims to overcome the rejection under 35 U.S.C. 101, discussed above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**As to claim 1, line 11**, “the file name” lacks antecedent basis. Furthermore, “the recording area of the file” lacks antecedent basis.

**As to claim 2, line 3**, “the number of (second) files... is greater than...first file...” should be changed for proper antecedent basis because claim 1 recites just one “second file.”

**Claims 3-6** are rejected because they depend from rejected claim 1.

**Claims 7-8** are rejected for similar reasons as claims 1-2.

**Claim 9** is rejected because it depends from rejected claim 7.

**As to claims 10-11**, “the recording area” lacks antecedent basis.

**As to claim 12**, use of the word “type” appears to render the scope of the claim indefinite. The addition of the word “type” to an otherwise definite expression (e.g.,

Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955). Likewise, the phrase “ZSM-5-type aluminosilicate zeolites” was held to be indefinite because it was unclear what “type” was intended to convey. The interpretation was made more difficult by the fact that the zeolites defined in the dependent claims were not within the genus of the type of zeolites defined in the independent claim. *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986). See MPEP 2173.05(b).

**Claims 13-14** are rejected because they depend from rejected claims 1 or 7.

The claims should be carefully revised to correct any antecedent basis, grammar, punctuation, and spelling errors similar to the above.

The broadest reasonable interpretation of the above terms in light of the specification has been given to the claims. Art rejection of the above claims is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph, discussed above.

#### ***Claim Rejections - 35 USC § 103***

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 1-9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caffarelli et al (U.S. Patent 6,091,686).**

**As to claim 1,** Caffarelli teaches the following claimed subject matter:

A recording medium (e.g., CD-ROM) in which a file for storing write data and file management information for managing the file have been recorded (e.g., fig. 6), wherein:

Said file management information comprises first file management information for managing a first file (e.g., fig. 6, #270, #280, #285), and second file management information for managing a second file (e.g., fig. 6, #250, #260, #265);

Said first file management information includes management information for managing said second file management information (e.g., col. 9, ll. 40-43).

Each of the first and second file management information consists of at least a table (see path table, fig. 6).

Caffarelli does not expressly teach wherein the table stores information indicating a file name.

However, Caffarelli teaches that the table (path table, fig. 6) is “similar to the ISO-9660 path table” which is shown in fig. 5. The ISO Path table stores “information indicating the file name” as claimed. Since the path table of fig. 6 is similar to the one in fig. 5, the table of fig. 6 could have the information seen in fig. 5.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caffarelli with the above teachings, such that the path table of fig. 6 includes information indicating the file name. The motivation would have been to retain at least some compatibility with the ISO-9660 file structure, as taught throughout Caffarelli (e.g., col. 8, ll. 45-65).

Caffarelli as modified above does not expressly teach another table indicating a recording area of the file.

However, Caffarelli teaches that the path table also indicates a recording area of the file (see fig. 5).

Furthermore, it has been held that making separable and making integral is obvious. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961), *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

In this case, although the path table is shown as a single table comprising several fields (fig. 5, col. 8, ll. 35-45), the path table can also be understood as more than one individual tables having one or more fields each, and collectively forming the path table as shown. Therefore, “another table(s),” as claimed, can be implemented.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caffarelli with the above teachings, such that

“another table for storing information indicating the recording area of the file” is implemented. The motivation would have been to conform to the user’s particular requirements in setting up the file system shown by Caffarelli.

**As to claim 2,** Caffarelli as modified above does not expressly teach wherein the number of files managed in the second file management information is greater than the number of files managed in the first file management information.

However, Caffarelli suggests the above. Caffarelli states, “when an incremental change is made to a file or directory, it is not necessary to rewrite the entire file/directory structure...the new path table contains pointers to the unchanged file/directory records. In addition, the new path table contains a pointer to the previous VDS. The previous path table also contains a pointer to any... previous VDS...” (col. 9, ll. 15-43). Thus, it is possible for there to be more “old” files (fig. 6, #265) than there are new files (#285), considering that Caffarelli teaches performing incremental changes.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caffarelli with the above teachings, such that there are more files in the second management information than there are in the first file management information. The motivation would have been to perform incremental changes, taught by Caffarelli.

**As to claim 3,** Caffarelli as modified above further teaches wherein the first file management information includes attribute information that indicates the first file and the second file management information (e.g., see fig. 6 and related text).

**As to claim 4**, Caffarelli as modified above further teaches wherein the attribute information includes file management information name or file name (e.g., see fig. 5-6, col. 8-9).

**As to claim 5**, the management information managing the second file management information (see fig. 6) has to be a recording area of the second file management information (e.g., on CDROM, fig. 1).

**As to claim 6**, Caffarelli as modified above further teaches wherein the first file management information manages the second file management information (see fig. 6) and the second file as a single file (also see fig. 6, col. 9, ll. 25-45). Note that the second file is an old file, and since it is unchanged, it is still managed as a single old file by the new path table pointing to the old file.

**Claim 7** is rejected because it contains limitations that were addressed with respect to claim 1, in addition to “management information for managing said second file as a file” which is met by Caffarelli in fig. 6.

**Claim 8** is rejected because it claims substantially the same invention as claim 2, discussed above.

**As to claim 9**, Caffarelli as modified above further teaches wherein the first file management system manages the second file management information as a different file (see fig. 6). The second file management information (fig. 6, #250, #260, #265) is a different file from the first file management system (fig. 6, #270, #280, #285) at least because they are located separately from each other, as seen in the figure. The second file also comprises original file information, as discussed above.

**As to claim 12**, Caffarelli as modified above further teaches wherein data is written into the first file or the second file stored in a recording medium (fig. 1, fig. 6) can be chosen according to the type of data to be recorded (for example, if the file is a new type of file, it is written to the first file, if the file is an original type of file, it is written to the second file).

**As to claim 13**, Caffarelli as modified above further teaches wherein PC file information (e.g., Windows files) is recorded on at least the first or second file (col. 6, ll. 29-56, col. 8-10, fig. 6). Caffarelli further teaches incremental changes, and the file system structure for accommodating them, as discussed above.

Caffarelli does not expressly teach AV file information (audio visual).

However, official notice is taken that at the time the invention was made, it was conventional to store AV files on a compact disk (e.g., movie clips). Furthermore, it was conventional for AV files to be PC file information (e.g., movies that are in a specified PC/Windows format).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Caffarelli with the above teachings, such that PC file information is stored in both first and second files, and both files are AV information. Therefore, the claimed "AV file written in the first file and PC file written in said second file" would be implemented, because both files would be AV and PC information. The motivation would have been to store a user's files on a compact disc, as known to one of ordinary skill in the art, as well as to allow for incremental file changes, as taught throughout Caffarelli.

**As to claim 14**, Caffarelli as modified above further teaches a reproducing apparatus for reading out and reproducing data from the first or second file stored in a recording medium according to claim 1 (see fig. 1-12 and related text).

**12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caffarelli et al (U.S. Patent 6,091,686) in view of Tol et al (Pub. No. 2002/0161774).**

**As to claim 10 and claim 11**, Caffarelli as modified above does not expressly teach a recorded anchor descriptor indicating the recording area of the first file management information and the second file management information.

However, Tol teaches a recorded anchor descriptor indicating the recording area of at least a first file management information (fig. 1-3, related text). Caffarelli teaches a recorded first and second file management information, as discussed above.

Furthermore, it has been held that duplication of parts is obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). In this case, the anchor descriptor of Tol can be duplicated in the environment of Caffarelli such that there is an anchor descriptor for each of the first and second file management information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Caffarelli with the above teachings, such that an anchor descriptor is recorded for each of the first and second file management information. The motivation would have been to find a reference to a file system's management information area for volume structure, as conventionally known and stated by Tol (para. 0002).

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***Conclusion***

13. The following prior art cited on the PTO-892 form, not relied upon, is considered pertinent to applicant's disclosure:

Auricchio et al. U.S. Patent 5,483,655. "Method for Extended File Access."

James, Kenneth. U.S. Patent 6,530,009. "Methods for Increasing File Storage Capacity of Optical Discs."

Mons, Johannes. U.S. Patent 6,353,580. "Method and Device for Storing Audio Centered Information And A File Based Access Mechanism."

Ooishi et al. U.S. Patent 5,628,010. "Method and Device for Accessing Character Files Image Data."

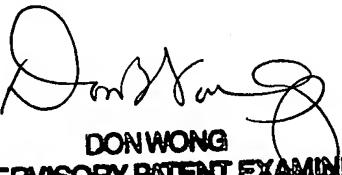
Taira et al. U.S. Patent 6,094,414. "Optical Recording Medium Capable of Recording Information Data File."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL  
Assistant Examiner  
AU 2163  
4/7/2006



DON WONG  
SUPERVISORY PATENT EXAMINER